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405787—41

In the Supreme Court of the United States

OCTOBER TERM, 1941

Nos. 257, 258, 259

MINNESOTA MINING & MANUFACTURING COMPANY, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The memorandum opinions of the United States District Court for the District of Columbia (R. 79–85; 278–280) are not reported. The opinion of the Court of Appeals (R. 307–310) and its opinion on rehearing (R. 332–333) are reported in 118 F. (2d) 593.

JURISDICTION

The judgment of the United States Court of Appeals for the District of Columbia was en-

Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

STATEMENT

Petitioner is the assignee of two patent applications of Byron J. Oakes, Serial Nos. 228,188 and 558,872, and one of Howard G. Bartling, Serial No. 692,436 (R. 85, 280). The claims of these applications are for abrasive sheets or belts comprised of a backing and an abrasive grit bonded to it. The gist of the claims is that they disclose vinyl resins as a binder (R. 85–86, 280). The applications in question were rejected by the Patent Office on the ground that invention was lacking because the use

of vinyl resins in making abrasives was taught by combining prior art (R. 63, 210, 276). The Patent Office, however, granted subsequent claims of other persons which were substantially identical to the claims rejected in the instant case (R. 67, 95). Petitioner thereupon filed suit in each of the applications in the United States District Court for the District of Columbia, seeking, under the provisions of section 4915 of the Revised Statutes, a declaration that it was entitled to the issuance of a patent.

The use of varnishes as bonds and the use of celluloid varnishes or lacquers as bond agents for sandpaper was well established before the filing of the petitioner's applications (R. 83, 280–281). The prior art also disclosed the use of vinyl resins in the varnish field and the feasibility of substituting such resins for celluloids as binders (R. 83, 280–281). In addition, the Benner patent No. 1,825,771 disclosed an abrasive article in which the abrasive particles are held together by a bond formed of organic materials, one of which the trial court found was a vinyl compound (R. 281).

The district court held that, in the light of the prior art the use of vinyl resins for binders was an obvious development in the art and found that, as to all but two of the claims involved,[2] no inven-

[2] The district court held claims 4 and 5 of Oakes' application Serial No. 228,188, disclosed invention inasmuch as they solved a problem of the glass industry in providing a wet abrasive belt (R. 84, 89).

tion was disclosed [3] (R. 83, 89, 280–281). It entered judgment accordingly (R. 90, 282). Petitioner appealed to the Court of Appeals for the District of Columbia.

While the appeals were pending, petitioner filed a motion with the court of appeals asking leave to apply to the district court for a rehearing and for consideration of newly discovered evidence (R. 296). The ground for the motion was the declaration by the Patent Office of an interference between claims of a subsequent application of Oakes which petitioner contends were substantially identical with those here involved and the claims of a patent issued to Paulsen on March 25, 1938 (R. 300–301). The motion was denied (R. 305–306). The Court of Appeals for the District of Columbia thereafter affirmed the judgments of the district court (R. 310–311). A motion for rehearing was denied on February 12, 1941 (R. 332–333). A motion for

[3] The district court's finding of no invention was included in its conclusions of law in one case, and in its memorandum opinion in the other two cases. In none did it include the finding of no invention in its findings of fact. The court below treated the finding as one of fact. The district court's failure to include the finding in its findings of fact was first adverted to by petitioner in its motion for rehearing by the court below. The court held, however, that such failure was harmless error and one which in any event was waived by petitioner in the appeal, because it made no mention of the matter in the statement of points upon which it intended to rely nor in its brief and oral argument (R. 332–333). Petitioner does not now seek review of the disposition of this point by the court below.

leave to file a bill of review in the district court was denied on April 29, 1941 (R. 334–335).

ARGUMENT

The court below held that the District Court's finding of no invention could not be disturbed if supported by substantial evidence. It further held that there was substantial evidence to support such finding and that issuance of patents by the Patent Office in similar claims did not require a contrary conclusion. The decision below is correct and presents no question requiring review by this court.

1. The question of invention is one of fact. *United States* v. *Esnault-Pelterie,* 299 U. S. 201, 205. The scope of appellate review in an action brought under the provisions of R. S. 4915, in so far as it relates to a question of fact, was accurately stated by the court below to be limited to the question of whether the finding that there was no invention was consistent with the evidence or was supported by the evidence[4] (R. 309). A proceeding under R. S. 4915 is an equity action, and follows the ordinary course of equity practice and procedure. *Butterworth* v. *Hoe,* 112 U. S. 50, 61. It is well established that the findings of fact of the trial court in an equity case will not be disturbed unless clearly erroneous or without support in the evidence. *Warren* v. *Keep,* 155 U. S. 265; *Furrer* v. *Ferris,*

[4] Petitioner does not deny that there was substantial evidence to support a finding of no invention.

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[4] Petitioner does not deny that there was substantial evidence to support a finding of no invention.

145 U. S. 132; *Tilghman* v. *Proctor,* 125 U. S. 136, 149; *Borden's Farm Products Co., Inc.,* v. *Ten Eyck,* 297 U. S. 251, 261; *Great Atlantic & Pac. Tea Co.* v. *Grosjean,* 301 U. S. 412, 420. The doctrine is applicable in principle to proceedings under R. S. 4915 and has been so applied by the court below in previous cases. *Abbott* v. *Coe,* 109 F. (2d) 449, 451; *Eppensteiner* v. *Coe,* 114 F. (2d) 457; *Forward Process Co.* v. *Coe,* 116 F. (2d) 946, 947. Cf. *Walker,* Patents (Dellers ed.), sec. 629. It is of peculiar force where, as here, the contested finding has been concurred in by both the Commissioner of Patents and the district court. *Abbott* v. *Coe,* at p. 452; cf. *United States* v. *Commercial Credit Co., Inc.,* 286 U. S. 63, 67.

The cases cited by petitioner (Pet. 11–12) in support of a contrary rule are not in point. They all involved a direct appeal from the Patent Office either to the Court of Customs and Patent Appeal or the Court of Appeals of the District of Columbia prior to the transfer of jurisdiction of such appeals from the latter to the former court. Act of March 2, 1929, 45 Stat. 1475, 1476. In such cases, as this Court has held, the Court of Appeals was "made part of the machinery of the Patent Office for administrative purposes" and rendered "a mere administrative decision." *Postum Cereal Co.* v. *Calif. Fig Nut Co.,* 272 U. S. 693, 698–699. Such decisions plainly have no bearing on the scope

of appellate review of the findings of the trier of fact in judicial proceedings.[5]

2. Petitioner also urges that the action of the Patent Office in granting patents on applications filed subsequent to the filing of the instant applications and containing claims substantially identical with those rejected in the instant case is of itself sufficient evidence that the claims in suit involved invention. Assuming, for purposes of argument, as did the court below, that the claims are substantially the same, the contention is yet without merit.[6] The sole question involved on review of the judgment of the district court was whether its finding was supported by substantial evidence. It is immaterial that there was evidence from which a contrary conclusion could have been, but was not required to be, drawn either by the Patent Office or the district court.[7]

CONCLUSION

The decision of the court below is correct and proceeds upon familiar and well-settled principles.

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[5] The rule for which petitioner contends was mentioned in *Battery Patents Corp.* v. *Coe*, 93 F. (2d) 220, 226–227 (App. D. C.), involving an action under R. S. 4915, but the court found it unnecessary to determine whether it was controlling in such proceedings.

[6] Respondent's contention that the claims were distinguishable was not passed upon below.

[7] Petitioners do not contend that the substantiality of the evidence in the instant case is dissipated by the Patent Office's action in granting indistinguishable patents.

There exists no conflict. We respectfully submit that the petition for a writ of certiorari should, therefore, be denied.

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